



10-25-05

TPW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hilda E. Smith

Serial No.: 10/632,117

Filed: July 31, 2003

For: ENVIRONMENTALLY
REGULATED GENES OF
STREPTOCOCCUS SUIS

Confirmation No.: 5350

Examiner: J. Hines

Group Art Unit: 1645

Attorney Docket No.: 2183-6055US

NOTICE OF EXPRESS MAILING

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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This amendment is in response to the Restriction Requirement of 26 July, 2005.

Claims 11-15 are currently pending in the application and subject to a Restriction Requirement. The applicant provisionally elects invention VIII, comprising SEQ ID NO:37 with traverse. Applicant wishes to respectfully point out that MPEP § 803.04 specifically allows an inventor to claim up to ten distinct nucleotide sequences in a single application without burdening the search capabilities of the Examiner or the Office. Therefore, applicant requests that the restriction requirement be withdrawn. This restriction is made without prejudice or disclaimer.

DISCUSSION

Following an Examiner interview held on 28 March, 2005, wherein the scope of the claims was discussed, applicant specifically limited the scope of Claim 11 of the instant application to ten nucleic acid sequences (SEQ ID NOS: 15, 16, 17, 24, 31, 33, 34, 37, 41 and 43) as requested by the Examiner.

This request and the applicant's subsequent compliance are consistent with stated Office practice. Namely, the MPEP states in § 803.04 that

to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application.

MPEP § 803.04. The term "reasonable" is further defined in § 803.04 as "ten sequences." *Id.* § 803.04 goes on to say that "[i]n some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten." *Id.* This is not an "exceptional" case as defined in § 803.04. That is, this is not a situation where complex features of the sequences such as three-dimensional fold are claimed. The applicant respectfully requests that the Examiner follow the guidelines laid out in MPEP § 803.04 allowing up to ten distinct nucleotide sequences in a single invention.

Applicants respectfully request that the Examiner apply the reasoning of MPEP § 803.04 and allow the related sequences of claim 11 to be claimed in a single application "to further aid the biotechnology industry." Applicants note that requiring a restriction among these sequences, as now present in the application, will further burden the Office by requiring subsequent applications claiming the non-elected sequences and burden the applicant with significant filing fees.